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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,586	04/08/2004	Boris Mayer	30691/DP008	8111
4743 7590 01/11/2008 MARSHALL GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER NGUYEN, NAM V	
			ART UNIT 2612	PAPER NUMBER
			MAIL DATE 01/11/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,586

Applicant(s)

MAYER ET AL.

Examiner

Nam V. Nguyen

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is in response to applicant's Amendment filed October 31, 2007 by a Request for Continued Examination.

Claim 21 is added.

Claims 12-18 and 20-21 are now pending in the application.

Response to Arguments

In view of applicant's argument to obviate the 35 U.S.C. §112 rejections, the arguments are persuasive, therefore, examiner has withdrawn the rejection under 35 U.S.C §112, second paragraph.

Applicant's argument to the rejected claims are insufficient to distinguish the claimed invention from the cited prior arts or overcome the rejection of said claims under 35 U.S.C § 103(a) as discussed below. Applicant's argument with respect to the pending claims 12-18 and 20-21, filed October 31, 2007, have been fully considered but they are not persuasive for at least the following reasons.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there

must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

Moreno discloses that a locker may be any suitable storage container including garages, mailboxes, heated/cooled compartments, and other storage units. The kiosk may also include other vending machines and dispensing devices, the operation of which are preferably controlled by the server. A system utilizes a storage unit which contains a plurality of individual lockers. The server also allows a merchant to identify those customers or potential customers to whom additional bargains, offers, or promotions may be made. By aggregating the demand for a given good at particular locations, the vendor is able to lower delivery costs and offer a discount to the customer (column 2 lines 36 to 52; see Figure 1). Clearly, Moreno discloses a customer (i.e. a user) can operates/controls a plurality of lockers that he/she is registered through a controller/server. Moreno discloses the system 100 includes the controller 110 connects to plurality of lockers 120. The locker 120 utilizes by itself or in combination with other lockers, which may also be of a different size, shape, configuration and features (column 4 lines 28 to 59; see Figure 1). Clearly, one of ordinary skilled in the art recognizes that the controller operates/functions to open several lockers when activating by the user.

Gokcebay et al, in the same field of endeavor, teach of a system for receiving and delivering articles utilizing automated bank of lockers as shown in Figures 1-3. Customers can

place orders through vendor's website (col. 3, lines 19-51). "A delivery person (i.e. registered user) associated with a vendor (i.e. user group) can open the locker by using a special key or keying in a special code, either on a terminal or on a keypad" (i.e. activating a function) (paragraph bridging cols. 2 and 3; col. 5, lines 4-8). "The delivery person can request four compartments for four different deliveries but simultaneous deliveries, and four available locker compartment doors will open" (i.e. an essentially simultaneous opening of several parcel compartments) (col. 5, lines 4-8). Clearly, Gokcebay et al. disclose a function that causes an essentially simultaneous opening of several parcel compartments in order to improve efficiency for the delivery person.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to recognize opening of several parcel compartment simultaneously taught by Gokcebay et al. in the server that controls the accessing and operation of the lockers directly of Moreno because opening of several parcel compartment simultaneously would reduce time and improve efficiency in the system for remotely controlling secure lockers.

On page 7, second paragraph, Applicant's arguments with respect to the invention in Moreno and Gokcebay et al. that whether or not several parcel compartments may open simultaneously has absolutely no bearing on motivation as relied upon by the office action is not persuasive.

As defined by claims 12 and 13, Gokcebay et al. disclose a networked digital locker lock system includes a central system processor 45 connects to plurality of lockers/locks in a plurality of locations by a BUS 52. Customers 40 and delivery person from a plurality of delivery

companies have access codes uniquely to each lockers/locks along with locker number for opening assigned lockers (column 4 lines 10 to 45; see Figure 5). Assignment of the delivery person to one of the delivery companies for delivering packages to the lockers. The delivery person can request four compartments for four different deliveries but simultaneous deliveries, and four available locker compartment doors will open. The delivery person inserts a scanner to the socket 15 (shown in FIG. 1) which also identifies the delivery company. The delivery person scans the package label and a locker compartment identifier to identify which package was delivered to what compartment and this information can be used by the locker system application software to generate e-mail or other communication to the consumer (column 5 lines 3 to 13). Clearly, the networked digital locker lock system includes a function that causes an essentially simultaneous opening of several parcel compartments in order to provide a convenient way of delivery packages for delivery person. It would be inconvenient for the delivery person to open one locker at a time, whereas, a delivery person can request to open four compartments at the same time would improve efficiency. Therefore, it would have been obvious to a person of ordinary skill in the art to recognize opening of several parcel compartment simultaneously taught by Gokcebay et al. in the server that controls the accessing and operation of the lockers directly of Moreno because opening of several parcel compartment simultaneously would reduce time and improve efficiency in the system for remotely controlling secure lockers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreno (US# 6,882,269) and in view of Gokcebay et al. (US# 5,212,644).

Referring to claims 12 and 13, Moreno discloses a method and system for securing goods delivered to and retrieved from a secure storage unit (column 2 lines 36 to 52; see Figures 1 and 2), whereby information of registered users of the electronic parcel compartment system (100) is acquired via an input device (114) (column 4 lines 1 to 3; column 6 lines 61 to 66; see Figure 1), the method and system comprising:

Assigning a registered user to user group(s) (i.e. members of customers, carrier or delivery persons);

Register customers have access to a selection of several functions (such as pick-up delivery (604), ship packages or exit) to the secure delivery system (100) depending on the user group (column 19 lines 33 to 38; see Figures 4 and 6B) to which the user belongs;

Effectuating control of access possibilities, whereby the user is given access to a particular starting menu (see Figure 5A-5B and 6B) of the registered user's user group (i.e. members of customers or carriers), wherein at least one of certain lockers and groups of lockers are accessible only to certain user groups (column 16 lines 44 to column 17 lines 16; column 19 lines 12 to 55; see Figures 5B to 5C and 6B to 6D).

However, Moreno does not disclose expressly "activating a function that causes an essentially simultaneous opening of several parcel compartments". Gokcebay et al, in the same field of endeavor, teach of a system for receiving and delivering articles utilizing automated bank of lockers as shown in Figures 1-3. Customers can place orders through a vendors website {Gokcebay, col. 3, lines 19-51+}. "A delivery person (i.e. registered user) associated with a vendor (i.e. user group) can open the locker by using a special key or keying in a special code, either on a terminal or on a keypad" (i.e. activating a function) {Gokcebay, paragraph bridging cols. 2 and 3; col. 5, lines 4-8+}. "The delivery person can request four compartments for four different deliveries but simultaneous deliveries, and four available locker compartment doors will open" (i.e. an essentially simultaneous opening of several parcel compartments) {Gokcebay, col. 5, lines 4-8+}. Gokcebay suggests that such features is advantageous because it alleviates the difficulties of many two income families receiving packages at home, and alleviates the suffering of delivery companies delivering the packages as they very often have to make several trips to deliver and obtain signature {Gokcebay, col. 1, lines 9- 19+}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include "an essentially simultaneous opening of several parcel compartments" in the system and method for securing goods delivered to and retrieved from secure storage units of Moreno because, as taught by Gokcebay, it alleviates the difficulties of many two income families receiving packages at home, and alleviates the suffering of delivery companies delivering the packages as they very often have to make several trips to deliver and obtain signature.

Referring to Claims 14-16, Moreno in view of Gokcebay et al. disclose the parcel compartment system of Claim 13, Moreno discloses wherein the means for assigning the users to user groups makes this assignment on the basis of information transmitted via a data line (column 12 lines 27 to 42; see Figure 4).

Referring to Claim 17, Moreno in view of Gokcebay et al. disclose the parcel compartment system of Claim 13, Moreno discloses the assignment to the user groups is performed by acquiring user identification information and by making a comparison of the user identification information to an entry in a database (108) (column 19 lines 12 to 18; see Figures 1 and 6A).

Referring to Claim 18, Moreno in view of Gokcebay et al. disclose the parcel compartment system of Claim 13, Moreno discloses wherein different access authorizations (i.e. carriers uses ID number and members of customers use login and password) to functions of the electronic parcel compartment system can be selected for different user groups (column 16 lines 59 to column 17 line 16; see Figures 5B; and column 19 line 33 to 55; see Figure 6B).

Referring to Claim 20, Moreno in view of Gokcebay et al. disclose the parcel compartment system of Claim 13, Moreno discloses wherein the assignment of the parcel compartments to the user groups can be changed (column 17 line 63 to column 18 line 9; column 21 lines 57 to column 22 line 2; see Figures 5H and 7Q).

Allowable Subject Matter

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Referring to claim 21, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations wherein the user group comprises a group of registered users having the same access profile to the parcel compartment system, wherein the system control allows the registered users of the user group to have access to the selection of the several functions of the electronic parcel compartment system.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 571-272-3061. The examiner can normally be reached on Mon-Fri, 8:00AM - 5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Zimmerman can be reached on 571- 272-3059. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nam Nguyen
December 27, 2007



BRIAN ZIMMERMAN
SUPERVISORY PATENT EXAMINER